

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Greg Christopher, Jr. Art Unit : 2191
Patent No. : 7,624,394 Examiner : Qing Chen
Issue Date : November 24, 2009 Conf. No. : 6410
Serial No. : 10/716,916
Filed : November 18, 2003
Title : SOFTWARE INSTALLATION VERIFICATION

Commissioner for Patents
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 394 days to 587 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The *Wyeth v. Kappos* court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”
“B delay” begins only after the PTO has failed to issue a patent within three years, not before.
Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before January 18, 2005 (the date that is fourteen months after November 18, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on June 26, 2006, thereby according a PTO Delay of 524 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from January 19, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to June 26, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before March 17, 2009 (the date that is four months after November 17, 2008, the date on which an Appeal Brief was filed). The PTO mailed a Notice of Allowance on April 20, 2009, thereby according a PTO Delay of 34 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from March 18, 2009 (the day after the date that is four months after the date on which an Appeal Brief was filed), to April 20, 2009.

See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 558 days (i.e., the sum of 524 days and 34 days).

“B Delay”

The period beginning on November 19, 2006 (the day after the date that is three years after November 18, 2003, the date on which the application was filed), and ending November 24, 2009 (the date the patent was issued), is 1,102 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1). In the present application, a Request for

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Continued Examination was filed on May 7, 2007, and the patent issued on November 24, 2009, resulting in a period of 933 days that must be excluded from the three year delay calculation.

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4). In the present application, a Notice of Appeal was filed on September 16, 2008, and a Notice of Allowance was mailed by the PTO on April 20, 2009, resulting in a period of 217 days that must be excluded from the three year delay calculation.

The periods of the number of days excluded from the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 217 days, from September 16, 2008, to April 20, 2009, and as such are not included in the "B Delay" calculation.

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 169 days (i.e., 1,102 days minus 933 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 169 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

January 19, 2005, to June 26, 2006; and

March 18, 2009, to April 20, 2009.

As detailed above, "B Delay" accumulated during the following period:

November 19, 2006, to May 7, 2007.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before March 7, 2007 (the date that is three months after December 7, 2006, the date on which the Office Action was mailed). Patentee filed

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a response to the Office Action on May 7, 2007, thereby according an Applicant Delay of 61 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 8, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to May 7, 2007. See 37 C.F.R. § 1.704(b).

Payment of the issue fee was due on or before July 20, 2009 (the date that is three months after April 20, 2009, the date on which the Notice of Allowance was mailed). Patentee submitted payment of the issue fee on August 13, 2009, thereby according an Applicant Delay of 24 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from July 21, 2009, to August 13, 2009. See 37 C.F.R. § 1.704(c)(10).

The application became abandoned on July 21, 2009, for a failure to pay the issue fee on or before July 20, 2009 (the date that is three months after April 20, 2009, the date on which the Notice of Allowance was mailed). The PTO mailed a Decision on Petition reviving the application on October 8, 2009, thereby according an Applicant Delay of 79 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from July 21, 2009, to October 8, 2009. See 37 C.F.R. § 1.704(c)(3).

As the periods of Applicant Delay overlap (i.e., occur on the same calendar day) for a total of 24 days, from July 21, 2009, to August 13, 2009, Patentee respectfully submits that this period of delay may only be counted once, and as such should not be included in the Applicant Delay calculation.

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 140 days (i.e., the sum of 61 days and 79 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

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Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 394 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 727 days (i.e., the sum of 558 days of "A Delay" and 169 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 140 days (i.e., the sum of 61 days and 79 days); and
- 3) Total PTA should be calculated as 587 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0602001.

Respectfully submitted,

Date: January 25, 2010

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